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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,174	11/25/2000	Kia Silverbrook	NPA081US	3854

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,174

Applicant(s)

SILVERBROOK ET AL.

Examiner

Clement B Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

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DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

2. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-47 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-47 of copending Application No. *09/575,197.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Specification

4. The disclosure is objected to because of the following informalities: the related application information on page 1 is listed with the attorney docket numbers. Since the applications have since received US serial numbers, the attorney docket information should be replaced with the US serial numbers and all information should be updated as to status of such applications. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 8-20, 22-28, 33-41, 43-47 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 4 recites the limitation "the form" in line 1 of page 84. There is insufficient antecedent basis for this limitation in the claim. Should this form be bill?.

Claims 8, 10, 12, and 15 all state "the parameter" when it should actually be "the at least one parameter" to be consistent with other occurrences of the same recitation.

Claim 33 recites the limitation "the person" in lines 2 and 4 on page 89. There is insufficient antecedent basis for this limitation in the claim. The first occurrence of the recitation should be "a person."

In claim 20, the term "substantially" renders the claim indefinite.

Claim 23 is confusing because it is unclear if the "particular person" is the same as the person previously identified in claims 1 & 4 or a different person. Clarification is required.

Claims 9, 11, 13-19, 22, and 24-28 are indefinite because they depend from rejected base claim 4.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-19, 21, 23-24, 26-40, 42-44 and 46 are rejected under 35 U.S.C.

102(b) as being anticipated by the Perazza patent (5,326,959).

The Perazza patent discloses a method of enabling bill payment of bills comprising the steps of providing a person with a bill containing information relating to a payment (cot. 11, lines 1-13; receiving indicating data from a sensing device (cot. 16, lines 29-54 and

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cot. 11, lines 1822); and identifying at least one parameter relating to the payment (cot. 16, lines 24-54).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

10. Claims 20, 41 and 45 are rejected under 35 U.S.C. 103(a) as being

unpatentable over the Perazza patent in view of the PCT application WO 99/50787

(XEROX).

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the data being substantially invisible (claims 20 and 45) and the sensing device having a marking nib (claim 41). The XEROX reference teaches the data being substantially invisible (page 8, lines 23-25) and the sensing device having a marking nib (505, page 14, lines 10-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have substantially invisible data so as to interfere with other visible markings on the bill and to have a sensing device with a nib so that should marks be necessary on the bill, they can be made at the time of reading the bill with the sensing device.

11. Claim 22, is rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent in view of the Story patent (5,673,430). The Perazza patent discloses all

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the elements of the claimed invention, as stated above, except the bill using a mixture of multicast and pointcast communication protocols (claim 22). The Story patent teaches the use of multicast and pointcast communication protocols (col. 3, lines 14-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to use multicast and pointcast communication protocols so as to reduce operating costs.

12, Claims 25 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent in view of the Japanese Patent Abstract 10194562 A.

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the binding of a multipage bill (claims 25 and 47). The Japanese patent abstract reference teaches the binding of multiple pages of the bill (Solution portion of Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have a means of binding a bill having multiple pages so that the various pages will remain together and reduce the opportunity for them to become separated.

Conclusion

13. The prior art of record and not relied upon is considered pertinent to Applicants disclosure.

Pollin (US Patent 5,727, 249) teaches automated payment system and method.

Baus (US 4, 628,195 Patent) teaches credit card security system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone

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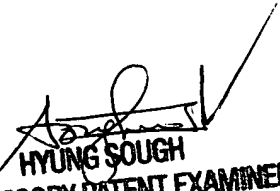
number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

January 12, 2004


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600